UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,671	04/16/2004	Michael Chen	BPCUR0007MC (C-52)	9595

27939 7590 04/05/2011

PHILIP H. BURRUS, IV
460 Grant Street
Atlanta, GA 30312

EXAMINER	
PARRA, OMAR S	
ART UNIT	PAPER NUMBER
2421	
MAIL DATE	DELIVERY MODE
04/05/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/826,671
Filing Date: April 16, 2004
Appellant(s): CHEN ET AL.

Philip H. Burrus
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/14/2011 appealing from the Office action mailed 06/22/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims in the brief is correct.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

2002/0184047	Plotnick et al.	12-2002
2003/0105831	O'Kane	6-2003
2003/0110499	Knudson et al.	6-2003
2004/0030599	Sie et al.	2-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims **1, 4, 5, 7-10, 13, 18-25, 27-32, 37, 38, 41-43, 48-50 and 52** are rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047) in view of O'Kane (Pub. No. 2003/0105831).

Regarding claims 1, 25 and 27, Plotnick teaches an apparatus for creating at least one targeted integrated image for delivery to a user **(130, Fig. 1; [0037]; [0039]; where the content provider 130 selects advertisements and send them along with the content, [0085])**, the apparatus comprising:

a processor for determining content of potential interest to the user based on at least one user preference **(The ads for selection are placed in queue or playlist**

from which the headend picks commercials. This queue includes targeted commercials that include at least one user preference, [0087]; [0101]; [0105]-[0106]). Given that the data to generate the queue -Universal Ad Queue, UAQ- is retrieved from a database and that the ads have pointers to be selected,[0039; [0057], it is inherent that at least one computer processor has to perform all the selection of the targeted ads), prior to or during the user's request for a first image comprising a video file or while the user is receiving the first image **(The selection of ads can be dynamic or it can follow a predetermined order of insertion, [0055]; [0556]; [0059])**, and

selecting a second image comprising a barker advertising the content of potential interest to the user from barker advertisements remaining in the queue **(different type of advertisements are chosen to be combined to the content: overlay ads, advertisement bugs, product placement ads, programming ads, VOD or PPV ads, etc, which are selected from the UAQ for presentation and put together with the content, [0047]-[0050])**, and wherein the processor determines the content of potential interest to the user that has not previously been viewed by the user **(One of the features of the UAQ is that it keeps track of what ad was already played and puts it at the end of the queue to make sure it does not repeat and other fresh ad is played next, [0058]; [0061])**;

a combiner for combining the second image with the first image to form a targeted integrated image for delivery to the user **([0012]; [0047]-[0050]; [0085]; [0109], where ads are inserted in the delivered content, and therefore, an inherent**

inserter or combiner must exist) and wherein the combiner inserts the second image within the first image.

Additionally, Plotnick teaches that the at least the one user preference comprises content ordering habits of the user **([0101]; [0104]; [0105]).**

On the other hand, although Plotnick teaches removing commercials off the UAQ based on different criteria ([0061]; [0081]). Plotnick does not explicitly teach determining content previously ordered or viewed by the user and removing from a queue barker advertisements corresponding to the content previously viewed by the user.

However, in an analogous art, O'Kane teaches a system that provides commercials associated to the distributed content (music or video). O'Kane teaches that once the commercial is played with its associated content, the commercial is deleted ([0075]-[0077]).

Therefore, it would have been obvious to one of ordinary skill in the art to have modified Plotnick's invention with O'Kane's feature of deleting the commercial once an associated content has been played for the benefit of narrowly targeting commercials and at the same time giving more space on the memory for new advertisements.

Regarding claims 4 and 28, Plotnick and O'Kane teach wherein content ordering habits includes at least one of information indicating times at which the user previously viewed or ordered content, genres of content previously viewed or ordered by the user, characteristics of content previously viewed or ordered by the user, and menu selections made by the user **(Plotnick: [0083]; [0084]; [0101]; [0104]; [0105]).**

Regarding claims 5 and 29, Plotnick and O'Kane teach further comprising determining an identity of the user, wherein the content of potential interest to the user is determined based on an at least one user preference associated with the identity of the user **(Plotnick: the ads of the queues are generated for a specific subscriber, 1 or 2, Fig. 20; [0148]-[0149]).**

Regarding claims 7 and 31, Plotnick and O'Kane teach further comprising determining images available in the queue **(advertisement on the queue are available for presentation; [0055]-[0059])**.

Regarding claims 8 and 32, Plotnick and O'Kane teach further comprising: marking the second image delivered to the user as having been delivered; and placing the marked image at the end of the queue, wherein the step of selecting selects images sequentially from the beginning of the queue **(Plotnick: [0055]; [0056]; [0061]; where the ads will be played in order unless there is a preference or weight for their presentation, at least in [0059]-[0060])**.

Regarding claim 9, Plotnick and O'Kane teach wherein the first image includes at least a menu or a programming guide **(Plotnick: [0051]; [0055]; [0056])**.

Regarding claim 10, Plotnick and O'Kane teach wherein the step of determining is initiated in response to the user accessing the menu or programming guide **(Plotnick: [0056])**.

Regarding claims 13 and 37, Plotnick and O'Kane teach wherein the step of determining is initiated responsive to the user requesting the video content **(Plotnick: [0038]-[0039]; [0047]-[0050]; [0059])**.

Regarding claims 18,19, 38, 41 and 42, Plotnick and O'Kane teach further comprising repeating the steps for creating at least one new integrated image for delivery to the user as the user continues to request or receive images **(As seen on Fig. 20, the integration of ads is repeated while the subscriber 1 keeps watching ABC. Given that queues are used for integrating commercials to content, and given that there is a plurality of ads in a queue, the process of integrating the ads and content has to repeat at least once more; [0054]-[0055]; [0059]).**

Regarding claims 20 and 43, Plotnick and O'Kane teach wherein the steps are recursively repeated for delivering new integrated images for delivery to the user **(The UAQ is generated periodically, [0081], and therefore, the integration of ads and content for delivery is repeated recursively).**

Regarding claim 21, Plotnick and O'Kane teach further comprising compressing at least one of the first image or the second image, prior to forming the integrated image **([0045])**.

Regarding claim 22, Plotnick and O'Kane teach wherein the step of combining includes inserting the second image within the first image wherein the first image is adapted to appear to the user to be paused **([0139]-[0140])**.

Regarding claim 23, Plotnick and O'Kane teach wherein the first image is adapted, for delivery to the user, to appear to be paused **(The PVR functions can be performed at the headend [0121]; therefore, the video content is delivered trick-played, i.e. paused, [0139]-[0140])**.

Regarding claim 24, Plotnick and O'Kane teach wherein the first image is adapted, upon delivery to the user, to appear to be paused **(The PVR functions can be performed at the user subscriber's location [0121]; therefore, the trick play features are performed at the local PVR, and the content is not delivered like that, i.e. paused, [0139]-[0140])**.

Regarding claims 30 and 52, Plotnick and O'Kane teach wherein the integrated image is configured to appear as a picture-in-picture display with the barker advertising the content of potential interest to the user presented as a first picture within a second picture of the video file **(For trick play content -content that allow pausing, rewind, skip, etc- an alternate advertisement –video ad- is presented on top of the tricked video file as a picture-in-picture, [0139]-[0140]. The PVR functions can be implemented entirely at the headend [0121]).**

Regarding claim 48, Plotnick and O'Kane teach wherein the integrated image is configured to appear as a picture-in-picture display in accordance with predetermined rules **(On VOD or PPV content, picture-in-picture ads are presented following certain rules, [0138]-[0140])**.

Regarding claim 49, Plotnick and O'Kane teach wherein the predetermined rules comprise presenting the barker advertising the content of potential interest to the user during an introduction of the video file **(VOD or PPV ads can be presented before the program or at the end of the program [0048])**.

Regarding claim 50, Plotnick and O'Kane teach wherein the predetermined rules comprise presenting the barker advertising the content of potential interest to the user during credits of the video file **(VOD or PPV ads can be presented before the program or at the end of the program [0048])**.

Claim **11** is rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047) in view of O'Kane (Pub. No. 2003/0105831) in further view of Knudson et al. (hereinafter 'Knudson', Pub. No. 2003/0110499).

Regarding claim 11, Plotnick and O'Kane teach all the limitations of the claim it depends on. On the other hand, although Plotnick and O'Kane teach determining ads

based on user's viewing habits, Plotnick and O'Kane do not explicitly teach monitoring user's menu or programming guide selections as the user navigates through the menu or programming guide.

However, in an analogous art, Knudson teaches a system for targeting advertisement to users (title; Abstract; [0011]). In order to target advertisement to users, Knudson teaches to monitor all the interactions of the user with the program guide ([0011]; [0071]), since the user's interactions with the program guide are indicative of the user's interest ([0005]). Knudson teaches that one of the user's monitored actions is the user navigation on the EPG ([0072]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Plotnick and O'Kane's invention with Knudson's monitoring of user's navigation interaction with the program guide for the benefit of using all or as many of the resources to get user's preference for a more accurate advertisement targeting.

Claim **51** is rejected under 35 U.S.C. 103(a) as being unpatentable over Plotnick et al. (hereinafter 'Plotnick', Pub. No. 2002/0184047) in view of O'Kane (Pub. No. 2003/0105831) in further view of Sie et al. (hereinafter 'Sie', Pub. No. 2004/0030599).

Regarding claim 51, Plotnick and O'Kane teach all the limitations of the claim it depends on. On the other hand, Plotnick and O'Kane do not explicitly teach wherein the barker advertising the content of potential interest to the user has a first genre

associated therewith, wherein the video file has a second genres associated therewith, wherein the determining content of potential interest to the user based on at least one user preference comprising content ordering habits of the user comprises selecting the first genre so as to be different from the second genre.

However, in an analogous art, Sie teaches a system that integrates served content with commercials (Abstract). Sie teaches monitoring user viewing habits and being able receive user's inputs ([0086]-[0090]). Sie teaches categorizing commercials, and if it is determined that the commercial should not be presented according to user's profile, even if a content with that category is chosen, a commercial under that category will be automatically skipped and will not be chosen, and instead, another commercial will be utilized ([0150]-[0151]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Plotnick and O'Kane's invention with Sie's feature of automatically not choosing or skipping a commercial when the category of the commercial and the content are the same and not allowed for the benefit of not showing commercials with categories not allowed when a program disliked by the user has been selected by mistake.

(10) Response to Argument

Appellant argues that *"…neither Plotnick nor O'Kane, alone or in combination, teaches a removal of barker advertisement, from a queue, where those barker advertisements correspond to content previously ordered or viewed by a user. O'Kane,*

like Plotnick, teaches removing advertisements after a predetermined number of views", pages 12 and 13. To this matter, the examiner respectfully disagrees.

Plotnick clearly teaches that, based on user preferences, the system creates a queue or playlist of advertisement that would be inserted to the ordered or selected content (The ads for selection are placed in queue or playlist from which the headend picks commercials. This queue includes targeted commercials that include at least one user preference, [0087]; [0101]; [0105]-[0106]). Plotnick additionally teaches that the system can remove advertisement (which includes different types of advertisements: overlay ads, advertisement bugs, product placement ads, programming ads, VOD or PPV ads, etc, which are selected from the UAQ for presentation and put together with the content, [0047]-[0050]) from the queue of advertisements based on different criteria ("played maximum number of times, ad campaign is over, new advertisers have purchased avails, existing advertisers have opted out of their avails, or any other number of reasons", [0081]). Plotnick, however, does not explicitly teach that the reason for removing of the advertisement is that the advertisement corresponds to content previously ordered or viewed by the user, as claimed.

O'Kane, on the other hand, teaches a system that permits commercial insertion on requested content. The selected commercials are based on user's preferences. O'Kane teaches on paragraph [0075] that selected commercials can exclusively correspond to a specific title or media content. Finally, O'Kane states that once a commercial is played (viewed by the user), the commercial is removed and therefore,

the user will only hear (view in the case of video being played) once per download ([0077]).

It is evident that by removing the commercial right after being played, the user will be able to see/hear the commercial only once per download. The examiner respectfully believes that O'Kane is trying to emphasize the fact that the commercial is removed after being played which will lead the user to only viewing/hearing it once per download, and not as being part of a playing frequency as suggested by appellant.

The claim language calls for removing an advertisement corresponding to the content previously ordered or viewed by the user. O'Kane, therefore, meets the limitation by removing a commercial that corresponds to a previously ordered content ([0075]-[0076]) or viewed by the user ([0077], where the user already viewed the commercial that comes with the previously ordered content).

Therefore, the examiner respectfully believes that the art of record covers appellant's invention as claimed.

It is also worth indicating that the claim language does not require removal of the advertisements based or it is because they correspond to content the user previously ordered or viewed.

After closely reading the claim language of the argued limitation by the appellant, the examiner is not able to find anything that states that the removal of the advertisement is based or it is performed because they correspond to content the user

previously ordered or viewed. In other words, the claim does not state why the ads are removed; it only requires those particular ads be removed.

O'Kane teaches a system that permits commercial insertion on requested content. The selected commercials are based on user's preferences. O'Kane teaches on paragraph [0075] that selected commercials can exclusively correspond to a specific title or media content. Finally, O'Kane states that once a commercial is played (viewed when it is a video commercial, by the user), the commercial is removed and therefore, the user will only hear (view in the case of video being played) once per download ([0077]).

Therefore, O'Kane clearly teaches removing commercials corresponding to content previously ordered or viewed by the user.

"O'Kane removes advertisements from the user's system, not a queue, after the advertisement has been viewed", page 14.

O'Kane was brought in to teach that removing advertisements that correspond to previously ordered content or viewed by the user is also a reason for removal of advertisement. It is Plotnick who teaches placing the commercials in a queue or playlist and removing them based on different other reasons.

Therefore, Plotnick and O'Kane, as a whole, teach appellant's argued limitation.

"Applicant's claim 1 removes the advertisement if it corresponds to previously ordered viewed content regardless of whether the advertisement has been viewed", page 14.

The claim language only calls for removing an advertisement corresponding to the content previously ordered or viewed by the user. O'Kane, therefore, meets the limitation by removing a commercial that corresponds to a previously ordered content ([0075]-[0076]) or viewed by the user ([0077], where the user already viewed the commercial that comes with the previously ordered content).

The argued limitation "regardless of whether the advertisement has been viewed" is not part of the claim language and therefore, the argument is moot.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Omar Parra

/Omar Parra/

Conferees:

/James Sheleheda/

Primary Examiner, Art Unit 2424

/Christopher Kelley/

Supervisory Patent Examiner, Art Unit 2424